

REMARKS

The Office Action of September 25, 2003 has been reviewed and these remarks are responsive thereto. This is a Request for Continued Examination. Claims 1-20 and 25-26 are pending. New claims 25-26 have been added. Claims 21-24 have been canceled, without disclaimer. Applicants request reconsideration and allowance of the instant application. No new matter has been added.

Claims 1-8, 10-18, and 20

Regarding claims 1-8, 10-18, and 20, the Office Action has relied on a proposed combination of U.S. Patent No. 5,737,599 to Rowe et al. ("Rowe") in view of U.S. Patent No. 5,557,722 to DeRose et al. ("DeRose"). A combination of Rowe and DeRose as proposed would not result in the present inventions. Rowe is only concerned with downloading of pages for optimization, not addressing the problems noted by applicants of the instant application. The present invention as recited in the claims 1 and 11 provides a technique for annotating an electronic file or page without corruption of the underlying file itself and allowing navigation within the file.

Claimed Features Are Not Met

Both Rowe and DeRose fail to teach or suggest the recited method for annotating a system having a display for displaying a page having user selectable objects being intermixed with markup tags, the objects and the markup tags being stored in a non-modifiable portion. For example, Rowe fails to teach or suggest the step of "receiving a user input for a selection of an object of said user selectable objects on the displayed page." The Office Action points to col. 16, lines 61-67 of Rowe. Notably, Rowe merely discusses a "designated order" for "an internal list of objects and lists of shared objects are created from the non-optimized portable electronic document." (Col. 15, lines 67 to col. 16, lines 1-2), but not the recited noted step. The designated order is merely dealing with downloading for displaying a page. Rowe states at col. 16, lines 61-67 that

In next step 98, the next object "on" page P is retrieved in a designated order, i.e., the next object referred to by the page P object in the designated order of objects. The "designated order" of objects is the order of objects in which
65 the provider of the optimized file (or the implementor of process 74) desires to be downloaded and displayed when accessing a page from the file. Thus, when downloading the

Rowe continues on at col. 17, lines 1-10 and states

optimized file 62, certain types of objects can be displayed first while other types of objects are still being downloaded. For example, it is typically desirable to display the text (i.e., page contents object) on a page before the images on the page when the page is downloaded, since the user who is
5 downloading the page can read the text while the images are still being downloaded. From the text content, the user can quickly determine if it is worth his or her time to wait for an image to be downloaded and be displayed, or if that page
download should be interrupted and a new page down-
loaded. 10

As can be seen from the above passages, Rowe clearly does not teach or suggest the recited step of "receiving user input for a selection of an object of said user selectable objects on the displayed page."

In addition, Rowe fails to teach or suggest the recited step of determining a position of the selected object in the non-modifiable portion of the file. The Office Action alleged "designated object" in the "designated order" of Rowe, e.g., (col. 16, lines 61-67) does not relate to the recited receiving step. In another example, Rowe and DeRose fails to teach or suggest a step of "providing a portion of the display configured for navigating to the previously selected object based on said position, when said annotation is subsequently selected." *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because a claimed feature was absent from a reference). Hence, at least for the noted reasons, Rowe fails to teach or suggest the method of claim 1 or computer readable medium of claim 11. Moreover, it is respectfully asserted that DeRose fails to make up for the deficiencies of Rowe. Thus, dependent claims 2-8, 10-18 and 20 are allowable in light of the respective independent claims, and for the further distinguishing features recited therein.

Claims 9 and 19

With respect to claims 9 and 19, the Office Action has relied on a combination of U.S. Patent No. 5,737,599 to Rowe et al. ("Rowe"). Rowe is only concerned with downloading of pages for optimization, not addressing the problems noted by applicants of the instant application. The present invention as recited in the claims 9 and 19 provides a technique for annotating an electronic file or page without corruption of the underlying file itself and allowing navigation within the file. To create an annotation, a user selects an object being displayed to locate where the annotation is to be placed. The computer system determines which object has been selected and determines a file position associated with the selected object. The system stores the position and the annotation separately from the non-modifiable portion of the file. The stored file position may be used to navigating to the location in the previously selected object where containing the annotation.

Other distinguishing features includes of the step of determining a position of the object in the non-modifiable portion of the file; includes counting the number of bytes from the beginning of the non-modifiable portion of the file to a first object on the displayed page object; counting the number of bytes from the first object on the displayed page to the selected object; and adding the number obtained from said first counting step to the number obtained from said second counting step to determine the file position of the object in the file.

Claimed Features Are Not Met by Rowe

Rowe clearly fails to teach or suggest the inventions of claims 9 and 19. When evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when they are missing from the prior art. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because a claimed feature was absent from a reference). As noted above, Rowe fails to teach or suggest the step of "receiving a user input for a selection of an object of said user selectable objects on the displayed page." In addition, Rowe fails to teach or suggest the recited step of determining a position of the selected object in the non-modifiable portion of the file. In another example, Rowe and DeRose fails to teach or suggest a step of "providing a user selectable portion on said display configured for

navigating to the previously selected object based on said position, when said annotation is displayed and subsequently selected.” Thus, for all the foregoing reasons, Rowe fails to teach or suggest all the features of claims 9 and 19. Accordingly, Applicants request withdrawal of the § 103 rejections.

There is no Motivation to Arrive at the Claimed Inventions

The Office Action states that “Rowe does not, explicitly disclose “counting the number of bytes from the first object and “adding the number obtained from the first counting step to the number obtained from the second counting step to determine the file position of the object in the file.” (Office Action ¶ 2, page 4). Clearly, Rowe does not disclose the noted features of Applicants.

Rowe with regard to so-called Hint tables does not teach or suggest the recited step determining the file position as recited in claims 9 and 19. The Office Action discusses portions of Rowe at col. 37, line 66 to col. 38, lines 28 relating to Rowe’s alleged description of “number of bytes from start of page to start of contents stream” and “added to the least start of contents offset.” Reproduced below are the statements in Rowe:

5 length of all previous pages. The “number of bytes from start of page to start of contents stream” is a value which, when added to the “least start of contents offset”, given in the header, gives the offset and bytes of the content stream object relative to the beginning of the page. The “length of

(Rowe, col. 38, lines 5-9).

The Office Action alleges that Rowe’s description of “number of bytes from start of page to start of contents stream” and “added to the least start of contents offset” in the above passage could be modified to the recited steps of “counting the number of bytes from the first object on the displayed page to the selected object; and adding the number obtained from said first counting step to the number obtained from said second counting step to determine the file position of the object in said file.” Notably, Rowe’s does not teach or suggest a selected object. Further, Rowe clearly fails to suggest the noted counting step and adding step as recited in claims 9 and 19.

Notwithstanding, Rowe’s lack of claimed features, there is no motivation to make the modifications to Rowe as proposed in the Office Action. The Office Action states that the motivation of modifying Rowe “would provide optimized page-based documents

without causing an excessive delay before displaying a page, or portions of a page to the user.” (Office Action ¶2, page 4). It is quite clear that “[t]he mere fact that prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)(reversing an obviousness rejection). It is respectfully submitted that there is no reason for one of ordinary skill in the art to modify Rowe’s page offset Hint Table to applicant’s recited counting step and adding step of claims 9 and 19. Claims 9 and 19 are allowable.

Claims 25 and 26

Rowe and DeRose fail to teach or suggest the inventions are recited in claims 25 and 26. Regarding claim 25 both references fail to teach or suggest a computer-implemented method for annotating an electronic book system having a display for displaying a page having user selectable objects, in which the user selectable objects are stored in a non-modifiable portion of a file and the recited steps therein. Regarding claim 26, both references fail to teach or suggest a computer apparatus configured for annotating an electronic book, including a processor; a display screen; and a memory configured to store computer executable instructions and an electronic book including a page having user selectable objects stored in a non-modifiable portion of a file and the recited steps. For claims 25 and 26, both references at least fail to teach or suggest the recited step of “providing a second display portion on said display configured for navigating to the previously selected object based on said file position, when said annotation is displayed and subsequently selected.”

Interview

Applicants’ representative wishes to thank the Examiners Le and Thai for granting an Examiner interview. During the interview, patents to Rowe and DeRose were discussed respect to claims 1, 9, 11, and 19. While no agreement was reached, it is believed that the prosecution has been advanced in the present application.

Conclusion

For all of the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact applicants' undersigned representative at the below-listed number. The Commissioner is authorized to charge additional fees for additional independent claims and dependent claims to our Deposit Account No. 19-0733. If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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